

**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Docket No: Q91757

Keijitsu TANAKA, et al.

Appln. No.: 10/565,554

Group Art Unit: 1645

Confirmation No.: 2075

Examiner: Khatol S. Shahnan Shah

Filed: January 23, 2006

For: METHOD OF DIAGNOSING WOOD DECAY AND DECAY DIAGNOSTIC AGENT

**REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION**

**MAIL STOP AF**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicant is in receipt of the Office Action dated March 31, 2010, in the above referenced application. Applicant respectfully submits that the finality of the Office Action is premature and therefore requests withdrawal of that finality, pursuant to MPEP 706.07(d).

MPEP 706.07(a) states: "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)."

On page 2 of the Office Action, the Examiner asserts that Claims 9 and 11-18 are rejected over the combination of Clausen *et al.* (US 5,563,040), Hirano *et al.* (J. of Wood Science, vol 46, 2000) and Khowala *et al.* (US 6,946,277) alone. The Examiner implicitly acknowledges (and

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attempts to rectify) a deficiency in the rejection of record (*i.e.*, that those of ordinary skill in the art, having read Khowala *et al.*, would not readily have employed cellobiose as the main carbon source), by newly citing to Lesage-Meessen *et al.* (US 5,866,380) as allegedly evidencing that cellobiose was well-known in the art to be useful as the main carbon source for culturing fungi. The Examiner has asserted that Lesage-Meessen *et al.* is prior art made of record and not relied upon, merely being pertinent to Applicant's disclosure (See page 9 of Office Action). However, given the extent of the Examiner's reliance on Lesage-Meessen *et al.* to provide motivation to employ cellobiose as the main carbon source, and to provide an expectation of success in doing so (*see* page 8 of the Office Action), the Examiner has substantially relied upon Lesage-Meessen *et al.* in rejecting the claims, despite the Examiner's assertion otherwise. Applicant made no amendments to the claims in the previous Response of January 4, 2010, nor was a Information Disclosure Statement submitted during the period set forth in 37 CFR 1.97(c). On this basis, Applicant submits the Examiner has introduced a new ground of rejection and that under current practice the Office Action should not have been made final. Therefore, Applicant requests that the finality of the Office Action be withdrawn.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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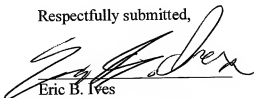
WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: June 25, 2010

Respectfully submitted,



Eric B. Ives  
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